

REMARKS

Applicant has carefully reviewed the substantive first Office Action dated June 8, 2007. In response, claims 43-55 are pending. Claims 1-42 stand canceled. All other claims remain as previously presented, with the exception of claim 43 which has been amended and claims 48-55 which are new. In view of the foregoing amendments and following remarks, Applicant respectfully requests favorable reconsideration of the rejections and objections made.

Presently, claims 43-47 stand rejected, their inventions allegedly being anticipated under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,423,874 to Stuff, Jr. and U.S. Patent No. 6,595,864 to Fuller. An “anticipation” rejection under Section 102(b) requires “strict identity” between the prior art reference and the one set forth in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (holding that an anticipating reference must describe all claimed aspects of the invention). The “mere possibility” that the claimed structure exists in the reference is inadequate to meet the “strict identity” requirement for a proper anticipation rejection. *See Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746 (Fed. Cir. 1991) (holding that anticipation “may not be established by probabilities or possibilities”). Thus, the references cited by the Examiner must expressly or inherently disclose the exact same invention, arranged precisely as required in the claims, in order for the rejections to be sustained.

Turning to the anticipation rejection of claims 43-47 based upon Stuff, Jr., as amended claim 43 now requires:

An alignment device for placing adjacent to and in front of a club head face to train a golfer to adopt a stance in which the golfer's eyes are positioned vertically above the device comprising: two upwardly spaced-apart members which when viewed from above are adapted to enable the upper one of the members to be located centrally in the lower one of the members such that said spaced-apart members produce an eclipse effect by the position of the upper one of said members in relation to the lower one of said members when the

golfer's eyes are correctly positioned directly above a center line of the club head.

Although the Examiner notes that Stuff, Jr. discloses two upwardly spaced-apart members (44 and 47), Stuff, Jr. does not teach said spaced-apart members producing an eclipse effect by the position of the upper one of said members in relation to the lower one of said members **when the golfer's eyes are correctly positioned directly above a center line of a club head** as required by claim 43. Instead, Stuff, Jr. states (referencing FIG. 8) "he [the golfer] looks directly down at the ball represented by vertical dash line C." *Col. 4, lines 57-60*. Accordingly, Stuff, Jr. teaches something completely different than what it is required in claim 43, namely, the golfer's eyes directly above a center line of a club head.

Additionally, Stuff, Jr. fails to teach (or even mention) that the two spaced-apart members produce an eclipse effect for the purpose of claim 43. As shown in FIG. 7 of the application, "the location of the upper plate 74 centrally in the lower plate 72 giving an 'eclipse' effect ensures that the golfer's eyes are directly above the centre line of the club head." In contrast, Stuff, Jr. teaches that "when the club is properly aligned, the line of sight shown by arrow A will cause black spot 44 as seen in FIG. 14 to meld with the area 47 which is also black to give a clear indication of a level club." *Col. 6, lines 4-7*. The purpose of the teachings in Stuff, Jr. is to maintain a level club in parallel with the surface of the green. Unlike Stuff, Jr., Applicant's alignment device is to position the golfer's eyes in the correct position directly above the center line of the club head. There is absolutely no evidence that use of the device in Stuff, Jr. will produce the claimed eclipse effect **when the golfer's eyes are directly above the center line of the club head**. Accordingly, Stuff, Jr. does not disclose the exact same invention as claim 43 (and the dependent claims 44-47) and the anticipation rejection should be withdrawn.

With respect to any assertion that this limitation of the claim constitutes an "intended use," Applicant notes the decision of the Court of Appeals of the Federal Circuit in *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). In *Stencel*, the Applicant claimed

a collar for use with a golf club based on an intended use. The CAFC in reversing the Board's finding of obviousness, held that the inventor "is not inhibited from claiming his [invention] . . . , *limited by the statement of its purpose*, and further defined by the remaining clauses of the claims at issue, when there is no suggestion in the prior art of [the invention] . . . having the claimed structure *and purpose*" (emphasis added). Here, there is no suggestion in Stuff, Jr. of the claimed structure and purpose of the alignment device of claim 43, so favorable treatment is in order.

Turning to the anticipation rejection of claims 43-47 based upon the Fuller reference, the Examiner points out that Fuller teaches an upper plate 12 and a lower plate 14. However, nowhere in Fuller is any mention made of the plates forming an eclipse effect when a golfer's eyes are positioned directly above the center line of the club head. In fact, the two plates disclosed in Fuller form a golf ball receiving and retaining structure when golfer puts a golf ball towards the putting practice device. Thus, Fuller does not comprehend positioning a golfer's eyes directly above the club head to view the eclipse effect of the plates. Rather, it is concerned with using the putting practice device to minimize turf damage experienced in practice putting greens. Accordingly, Fuller does not disclose or even remotely teach the exact same invention of claims 43-47 and the anticipation rejection should be withdrawn.

Turning to the formal issues, Applicant takes issue with the Examiner's specification objection. The Examiner contends that "for the elected species of figures 6-8 it is uncertain how this is made into a head" and "[t]here is no hitting face and it is uncertain how this alignment device would work for Figures 1 or 5." Applicant directs the Examiner to page 11, last paragraph of the specification, which refers to Figures 5-8. As noted in the specification and clearly shown, Figure 5 discloses a modification of the golf club disclosed in Figure 1. Figure 1 discloses a club head 10 comprising a housing block 12 secured to a carcass 14. Further, a club face portion 16 is permanently secured to the face of the housing block 12 remote from the carcass 14.

As shown in Figure 5, the carcass 14 is provided with an upper circular plate 70.

Further, as noted in the specification, Figures 6-8 disclose an alternative design of the upper circular plate 70. The two-spaced apart circular plates 72 and 74 connected together by a central stem 76 replace the circular plate 70. The carcass 14 is provided with the two-spaced apart circular plates 72 and 74, rather than the upper circular plate 70. In turn, the club face portion 16 would be permanently secured to the face of the housing block 12 remote from the carcass 14. Accordingly, the figures and the specification demonstrate how the alignment device relate to the club head. For at least this reason, the Applicant requests reconsideration.

Claims 43-47 also stand rejected under 35 U.S.C. § 112, first paragraph. The basis for this rejection appears to be the same as the specification objection, which Applicant believes is sufficiently addressed in the foregoing paragraphs.

Claims 43-47 also stand rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner contends that “Claim 43 is indefinite in that it states that the alignment device is adjacent to the front of a face and in front.” Contrary to the Examiner’s position, the specification sets forth “this type of ‘eclipse’ plate assembly...could be produced as a separate item for placing adjacent to and in front of the club head face.” *See p. 12, l. 26-p. 13, l. 4.* Moreover, the Applicant has the right to be its own lexicographer without any interference by the Examiner, as long as the terms used would be understood by a skilled artisan. The figures may be easily interpreted by a person skilled in the art as showing the alignment device adjacent to and in front of the club head face based upon the orientation of the club head face, and the Examiner has not established otherwise. Therefore, these claims are definite as written and no further explanation is necessary.

Applicant also presents new claims 48-55 for consideration, without adding any new matter. Claim 48 reads on the alignment device of claim 43, wherein the upper member comprises an upper plate having a first plurality of markings and the lower member comprises a lower plate disposed in parallel to said upper plate having a second plurality of markings corresponding to the first plurality of markings, and further including a connector

connecting the upper plate to the lower plate. Claims 49 and 50 require that the markings comprise radial or circular lines. Since the structural features of these claims are completely missing from the cited references, it is believed favorable treatment is in order.

New claims 51 and 53 require that the upper and lower members of the alignment device are of the same shape and size, while claims 52 and 54 require that these members are circular plates having the same diameter. New claim 55 requires a connector for connecting the plates of claim 54. Again, neither Fuller nor Stuff, Jr. discloses, teaches, or even remotely suggests such an alignment device. Accordingly, favorable treatment of these claims is in order.

In summary, it is now believed that all pending claims are allowable. If any issues remain, the Examiner is encouraged to contact the Applicant's counsel at the telephone number listed below in order to reduce costs and expedite the prosecution of this patent application. Applicant concurrently submits a request for a three month extension of time. Any fees due may be debited from Deposit Account No. 11-0978.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', is written over the firm name.

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